



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,038	11/18/1999	JAMES MCCROSSIN	11324/1	6686
7590	12/27/2007		EXAMINER	
SHAWN W O'DOWD KENYON & KENYON 333 W SAN CARLOS STREET SAN JOSE, CA 95110			KARMIK, STEFANOS	
			ART UNIT	PAPER NUMBER
			3693	
			MAIL DATE	DELIVERY MODE
			12/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE
2

3

4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7

8 *Ex parte* JAMES MCCROSSIN, DEAN HILLER, and RICHARD KORNUTIK
9

10

11 Appeal 2007-1796
12 Application 09/443,038
13 Technology Center 3600
14

15

16 Decided: December 27, 2007
17

18

19 Before HUBERT C. LORIN, ANTON W. FETTING, and DAVID B. WALKER,
20 *Administrative Patent Judges.*

21 FETTING, *Administrative Patent Judge.*

22 DECISION ON APPEAL
23

24 STATEMENT OF CASE
25

26 James McCrossin, Dean Hiller, and Richard Kornutik (Appellants) seek review
27 under 35 U.S.C. § 134 of a Final Rejection of claims 1-3, 7, 9, 10, 14-19, 23¹, and
28 24, the only claims pending and remaining under consideration² in the application
29 on appeal.

1¹ Claim 23 is shown as both remaining and withdrawn in the Appellants' claim appendix. Claim 23 actually remains under consideration, having been among the selected claims in the Appellants' election of February 13, 2002.

4² Claims 4-6, 8, 11-13, 20-22, and 25-43 are withdrawn from consideration.

- 1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).
- 2 We REVERSE.

3 The Appellants invented a way of providing information to a user based on a
4location of the user (Specification 2:3-4). A first computer collects information to
5be presented to one or more users. The information is organized into a plurality of
6first web-sites where each of these web-sites is addressable by a unique Universal
7Resource Locator (URL). A physical location is associated with each of the first
8web-sites. When the user or other individual seeks to access the user web-site,
9links to a plurality of the first web-sites are provided based on a relationship
10between the physical locations associated with the first web-sites and the physical
11location associated with the user web-site. For example, the physical location of a
12telephone connection may be the physical location of the first and user web-sites
13described above (Specification 3:11-21).

14 An understanding of the invention can be derived from a reading of exemplary
15claim 1, which is reproduced below [bracketed matter and some paragraphing
16added].

- 17 1. A method of providing information to a user comprising:
 - 18 [1] collecting information at a first computer system;
 - 19 [2] creating a plurality of first web-sites at said first computer system
20 from said information,
 - 21 each of said first web-sites being addressable by a unique
22 Universal Resource Locator (URL) and
 - 23 each of said first web-sites being identified by a physical
24 location;
 - 25 [3] assigning one of said first web-sites to a user as a user web-site;
26 and

1 [4] selecting links to a plurality of said first web-sites, other than said
2 user web-site,
3 for presentation on said user web-site
4 based on a relationship between
5 the physical locations identified by said first web-sites
6 and
7 the physical location identified by said user web-site.
8

9 This appeal arises from the Examiner's Final Rejection, mailed November 4,
10 2003. The Appellants filed an Appeal Brief in support of the appeal on May 22,
11 2006. An Examiner's Answer to the Appeal Brief was mailed on August 28, 2006.
12 The Appellants presented oral arguments at a hearing on November 15, 2007.

13 PRIOR ART

14 The Examiner relies upon the following prior art:

Torneta	US 5,032,989	Jul. 16, 1991
Bonnaure	WO 98/04088	Jan. 29, 1998

15 Xiaomin Ye, "A Proposal for a Geographic-Based Address Structure for IPv6,"
16 Master's Thesis, (1998)

17 REJECTIONS

18 Claims 1-3, 7, 9, 10, 14-19, 23, and 24 stand rejected under 35 U.S.C. § 112,
19 second paragraph, as failing to particularly point out and distinctly claim the
20 invention.

21 Claims 1-3, 7, 9, and 16-18 stand rejected under 35 U.S.C. § 103(a) as
22 unpatentable over Bonnaure and Ye.

23 Claims 10, 14, 15, 19, 23, and 24 stand rejected under 35 U.S.C. § 103(a) as
24 unpatentable over Bonnaure, Ye, and Tornetta.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-3, 7, 9, 10, 14-19, 23, and 24 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-3, 7, 9, and 16-18 under 35 U.S.C. § 103(a) as unpatentable over Bonnaure and Ye.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 10, 14, 15, 19, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over Bonnaure, Ye, and Tornetta.

13 The pertinent issues turn on whether Bonnaure and Ye describe collecting web
14sites, including a user's web site at a common computer, and using that user's web
15page as the platform for presenting web pages found based on the relationship
16between the physical locations identified by the user's and other's web pages.

FACTS PERTINENT TO THE ISSUES

18 The following enumerated Findings of Fact (FF) are believed to be supported
19 by a preponderance of the evidence.

20 Bonnaure

21 1. Bonnaire is directed toward a database central routing device for routing
22 incoming access requests for Internet access among a variety of on-line
23 service providers. The device generally includes a central server having
24 a list of algorithms pertaining to access phone numbers of Internet access

1 providers to be chosen from. The central routing device further includes
2 an automatic phone number identifier to identify incoming calls in order
3 to identify the user as a customer. An algorithm generator is also
4 included in order to download algorithms pertaining to particular phone
5 numbers in order to give the user access to a variety of Internet access
6 providers. The central routing device allows the user to select from a
7 number of Internet access providers depending on the availability of the
8 providers. Factors such as time of day, consistent peak and off peak
9 hours of any particular provider, the time of access, the type of user such
10 as consumer or business user, and other factors are considered in order to
11 make efficient use of a variety of Internet access providers (Bonnaure 3-
12 4 Summary of Invention).

13 2. In processing block 1410 (Bonnaure, Fig. 14), an encrypted service
14 request is received by WebTV server 620 from client 610. A client
15 network address is typically provided as part of the client service
16 request. Although the client network address typically represents a
17 logical network location of the client, in some networks, the client
18 network address can also be associated with the geographical location of
19 the client. For example, in a plain old telephone service (POTS)
20 telephone network, the client network address is represented as the
21 telephone number of a client. Using conventional techniques, a
22 telephone number can be associated with a geographical location. The
23 area code is a typical component of a client telephone number. The area
24 code is associated with a well defined geographical region as established
25 by the conventional telephone companies that manage the telephone
26 network. In addition, the three digit prefix of a seven digit telephone

1 number further identifies a particular geographical sub-region within the
2 region identified by the area code. The remaining four digits of a seven
3 digit telephone number further define a particular location within the
4 said-defined sub-region (Bonnaure 18: Bottom ¶).

5 3. Using this conventional telephone number information, a set of network
6 geographical data can be generated which associates telephone numbers
7 with particular geographical locations. This information is stored in
8 WebTV sever 620 in network geographical data 1012. In network
9 environments other than a telephone network, other associations between
10 client network addresses and corresponding geographical locations can
11 be defined and stored in network geographical data 1012 (Bonnaure 19:
12 Top ¶).

13 4. Client 610 benefits in a number of ways by having WebTV server 620
14 able to ascertain the geographical locality from which client 610 is
15 communicating with WebTV server 620. For example, various client
16 service requests can be optimized based on the geographical locality
17 from which the service request is originated. In the case of a business
18 transaction for example, a client may request the delivery of goods
19 through WebTV server 620. By knowing the geographical locality from
20 which the client originated the delivery request, WebTV server 620 can
21 select a delivery station geographically closest to the requesting client
22 (Bonnaure 19: Second ¶).

23 5. In the case of a telephone network, the server 620 uses the requesting
24 client's telephone number to determine a geographical location of the
25 client without the client having to specify its address, telephone number
26 or other type of locality information. The telephone number is mapped

1 to a geographical location using well known techniques, such as an area
2 code map database. Using the requesting client's telephone number, the
3 service provider or WebTV server 620 can select an appropriate supplier
4 or warehouse closest to the client's location. For example, a client could
5 order goods from a supplier who delivers the goods from a distant
6 warehouse even though a similar warehouse was located close to the
7 client's location (Bonnaure 19: Bottom ¶ - 20: Top ¶).

8 6. In other situations, a service provider can customize the services
9 provided based on the requesting client's telephone number. For
10 example, a specific menu of items associated with particular geographic
11 locations can be offered for particular clients based on the automatic
12 number identification (ANI)-derived requesting client's telephone
13 number. In another example, service offerings, prices of offerings, or
14 times of offerings can be varied based on the ANI-derived requesting
15 client's telephone number (Bonnaure 20: First full ¶).

16 7. If the client service request can be optimized for a particular
17 geographical location associated with the client, the client network
18 address is obtained in block 1414 (Bonnaure, Fig. 14). Using the client
19 network address, WebTV server 620 accesses the network geographical
20 data 1012 to determine the corresponding client geographical locality
21 (processing block 1416). Using the client geographical locality thus
22 obtained, the client service request can be optimized in processing block
23 1418. WebTV server 620 processing then terminates at the exit block
24 illustrated in Figure 14 (Bonnaure 20: Second full ¶).

25 8. The geographic tailoring enabled by the WebTV network of Bonnaure
26 offers several other advantages. By knowing where a particular client is

1 geographically located using the WebTV network interface device's
2 means for determining client location, the server response to client
3 requests can be tailored to the client's particular geographic locality. For
4 example, prior art systems provide a network capability with which a
5 client may order goods or services from a server using an on-line
6 service. These prior art servers, however, respond to every client request
7 in the same way regardless of the client's geographic location. In the
8 present invention, however, the server tailors its response to a particular
9 client by knowing the client's geographical location as determined using
10 the apparatus and processes described above. There can be an improved
11 difference in the response to clients because the WebTV server is able to
12 determine the geographical location of the requesting client using the
13 techniques described above (Bonnaure 21: First full ¶).

14 *Ye*

15 9. *Ye* is directed to a novel geographic-based internet protocol (IPv6)
16 addressing scheme. Based on the analysis of many important factors
17 such as sizes of apartments, geographic parameters, and distribution of
18 population, a coarse resolution is proposed for network entities (*Ye* xiii:
19 Top ¶).

20 PRINCIPLES OF LAW

21 *Claim Construction*

22 During examination of a patent application, pending claims are given
23 their broadest reasonable construction consistent with the specification. *In*
24 *re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*
25 *Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

1 Limitations appearing in the specification but not recited in the claim are not
2read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.
3Cir. 2003) (claims must be interpreted “in view of the specification” without
4importing limitations from the specification into the claims unnecessarily)

5 Although a patent applicant is entitled to be his or her own lexicographer of
6patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,
7347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such
8definitions in the Specification with sufficient clarity to provide a person of
9ordinary skill in the art with clear and precise notice of the meaning that is to be
10construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although
11an inventor is free to define the specific terms used to describe the invention, this
12must be done with reasonable clarity, deliberateness, and precision; where an
13inventor chooses to give terms uncommon meanings, the inventor must set out any
14uncommon definition in some manner within the patent disclosure so as to give
15one of ordinary skill in the art notice of the change).

16*Indefiniteness*

17 If a claim is not amenable to construction, the claim is invalid as indefinite
18under 35 U.S.C. § 112, second paragraph. *Novo Indus., L.P. v. Micro Molds*
19*Corp.*, 350 F.3d 1348, 1353 (Fed. Cir. 2003). If a claim is amenable to
20construction, “even though the task may be formidable and the conclusion may be
21one over which reasonable persons will disagree,” the claim is not indefinite.
22*Exxon Res. & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001).

23*Obviousness*

24 A claimed invention is unpatentable if the differences between it and the
25prior art are “such that the subject matter as a whole would have been obvious at
26the time the invention was made to a person having ordinary skill in the art.”

¹³⁵ U.S.C. § 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007);

²*Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: “[1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. See also *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. at 1734.

⁸ “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, at 1739.

10 "When a work is available in one field of endeavor, design incentives and
11 other market forces can prompt variations of it, either in the same field or in a
12 different one. If a person of ordinary skill in the art can implement a predictable
13 variation, § 103 likely bars its patentability." *Id.* at 1740.

14 "For the same reason, if a technique has been used to improve one device,
15and a person of ordinary skill in the art would recognize that it would improve
16similar devices in the same way, using the technique is obvious unless its actual
17application is beyond his or her skill." *Id.*

18 "Under the correct analysis, any need or problem known in the field of
19 endeavor at the time of invention and addressed by the patent can provide a reason
20 for combining the elements in the manner claimed." *Id.* at 1742.

ANALYSIS

22 *Claims 1-3, 7, 9, 10, 14-19, 23, and 24 rejected under 35 U.S.C. § 112, second*
23 *paragraph, as failing to particularly point out and distinctly claim the invention.*

24 The Appellants argue these claims as a group.

1 Accordingly, we select claim 1 as representative of the group.
237 C.F.R. § 41.37(c)(1)(vii) (2006).

3 The Examiner found that in claims 1, 16³, and 17, the limitation "each of said
4 first web-sites being identified by a physical location" is indefinite. The remaining
5 claims under this rejection depend from those claims. The Examiner finds that a
6 web site does not exist in the physical sense and finds it is confusing to suggest
7 that a web site can be identified by a physical location. The Examiner concludes
8 that this language causes confusion as to the metes and bounds of the claim
9 (Answer 3).

10 The Appellants contend that a web-site is a collection of web pages where each
11 web page is addressable by a unique URL. With such a data collection, the claim
12 language seeks to identify that web-site by a physical location (Br. 5: Bottom ¶ - 6:
13 Top ¶).

14 We find that web sites do exist in a physical sense as data files. As such,
15identification is readily made. A person of ordinary skill would understand that
16having a web site identified by a physical location means to have either the file
17names or contents or context of the files comprising a web site identify physical
18locations

19 The Appellants have sustained their burden of showing that the Examiner erred
20 in rejecting claims 1-3, 7, 9, 10, 14-19, 23, and 24 under 35 U.S.C. § 112, second
21 paragraph, as failing to particularly point out and distinctly claim the invention.

22 *Claims 1-3, 7, 9, and 16-18 rejected under 35 U.S.C. § 103(a) as unpatentable*
23 *over Bonnaure and Ye*

²⁴ The Appellants argue these claims as a group.

¹⁵ The Examiner refers to cancelled claim 6 rather than 16, which is clearly a typographic error (Answer 3).

1 Accordingly, we select claim 1 as representative of the group.

237 C.F.R. § 41.37(c)(1)(vii)(2006).

3 The Examiner found that Bonnaure discloses a method of providing
4information to a user; collecting information at a first computer system; organizing
5the information into a plurality of first web sites; that each of the first web sites are
6accessible by a network address associated with the client's geographical location;
7providing one of the first web-sites to a user as a user web-site; and selecting links
8to a plurality of first web sites for presentation on the user web site based on a
9relationship between the physical locations associated with the first web sites and
10the physical location associated with the user web site. The Examiner found that
11Bonnaure does not explicitly state that the network address is a unique Universal
12Resource Locator (URL) having a physical location associated therewith as
13claimed by the applicant. To overcome this deficiency, the Examiner found that
14Ye teaches a geographic-based URL address structure and the desirability of
15location dependent services. The Examiner concluded that it would have been
16obvious to a person of ordinary skill in the art to modify the teachings of Bonnaure
17with the geographic-based URL taught by Ye to arrive at the invention as claimed
18by the applicant (Answer 4-5).

19 The Appellants contend that Ye does not describe web sites, only internet
20protocols, and Bonnaure does not describe assigning one among many web sites all
21located on a common computer system to a user, who then selects links to the other
22web sites based on a relationship between the physical locations identified by the
23user's and the other web sites to present the selected web pages on the user's web
24page (Br. 7-10).

25 While we agree with the Examiner that Bonnaure clearly describes collecting
26information at a computer system and creating a database of web sites at that

1computer system, each of the web sites identified by a physical location, and
2selecting links to those web sites based on a relationship between the user's
3physical location and the location identified by the other web sites in the database
4(FF -), and Ye describes the desirability of geographic information in internet
5protocol addressing (FF), we are unable to find any description or suggestion in
6either reference for collecting web sites, including a user's web site at the common
7computer and providing the capability for presenting links, on that user's web site,
8to the web sites found based on the relationship between the physical locations
9identified by the user's and other's web sites.

10 Since a web site, as a term of art in computer technology, is a collection of one
11or more web page files, limitation [4] requires that at least one of the pages within
12the recited user's web site, which must be identified by a physical location by
13virtue of limitation [2], have the capacity to present the links to more than one of
14the remaining web sites, i.e. each link must point to a page within the respective
15web site. This capacity for presentation must be such that the links would be
16displayed on at least one page within the user's web site, and, by the property of
17links, each of those links must be capable of retrieving the web page within the
18web site pointed to. Finally, the links so selected must be selected based on a
19relationship between the physical locations identified by the collection of web sites
20in limitation [2] and the user's web site, implying that the pages within the
21collection of web sites and the user's web site must physically exist for such a
22selection criterion to be meaningful.

23 The Examiner directs us to Bonnaure 6: Bottom ¶ for the limitation of a user's
24web site(Answer 5: Fourth bullet). However, this portion of Bonnaure only
25describes conventional web browsing and does not specify which links to web sites
26are selected for presentation, much less assigning a web site to a user, selecting

1links that are capable of being presented on that user web site, and basing that
2selection on a relationship between the physical locations identified by the web site
3assigned to a user and the physical locations identified for other web sites. Thus,
4although all of the subject matter in claim 1 is described by Bonnaure and Ye,
5except the creation of such web sites, one of which is assigned to a user for both
6selection based on the physical location the web site identifies and presentation of
7the link selection results, this limitation is neither found nor suggested by either
8Bonnaure or Ye. Since the created web sites identified by a physical location
9element appears in limitations [2], [3], and [4] of claim 1, this must be considered a
10significant limitation requiring objective evidence that the Examiner has not
11provided. Thus, we must conclude the Examiner has failed to present a prima facie
12case for this rejection.

13 The Appellants have sustained their burden of showing that the Examiner erred
14in rejecting claims 1-3, 7, 9, and 16-18 under 35 U.S.C. § 103(a) as unpatentable
15over Bonnaure and Ye.

18 These claims depend from independent claims 1, 16, and 17. We found that
19the combined teachings of Bonnaure and Ye did not describe the web site
20limitations of the independent claims, *supra*, and Tornetta does not remedy this.
21Thus, these limitations, also present in these claims, are similarly not described in
22the art applied. The Appellants have sustained their burden of showing that the
23Examiner erred in rejecting claims 10, 14, 15, 19, 23, and 24 under 35 U.S.C. §
24103(a) as unpatentable over Bonnaure, Ye, and Tornetta.

1

CONCLUSIONS OF LAW

2 The Appellants have sustained their burden of showing that the Examiner erred
3 in rejecting claims 1-3, 7, 9, 10, 14-19, 23 and 24 under 35 U.S.C. § 112, second
4 paragraph, as failing to particularly point out and distinctly claim the invention,
5 and under 35 U.S.C. § 103(a) as unpatentable over the prior art.

6

DECISION

7 To summarize, our decision is as follows:

8 • The rejection of claims 1-3, 7, 9, 10, 14-19, 23, and 24 under 35 U.S.C. §
9 112, second paragraph, as failing to particularly point out and distinctly
10 claim the invention is not sustained.

11 • The rejection of claims 1-3, 7, 9, and 16-18 under 35 U.S.C. § 103(a) as
12 unpatentable over Bonnaure and Ye is not sustained.

13 • The rejection of claims 10, 14, 15, 19, 23, and 24 under 35 U.S.C. § 103(a)
14 as unpatentable over Bonnaure, Ye, and Tornetta is not sustained.

15

REVERSED

16

17

18

19jlb

20SHAWN W O'DOWD
21KENYON & KENYON
22333 W SAN CARLOS STREET
23SAN JOSE CA 95110

21